



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,753	10/29/2001	Yasuhiro Sakai	3029-74	7298

7590

07/25/2003

Lance J. Lieberman, Esq.
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, NY 10176

EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

10/005,753

Applicant(s)

SAKAI ET AL.

Examiner

Francisco C Prats

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1651

DETAILED ACTION

The amendment filed June 9, 2003, has been received and entered.

Claims 24-26 have been added.

Claims 1-26 are pending.

Election/Restrictions

Applicant's election of the group II invention, claims 20-23, the species wherein the nitrite reducer is sulfamic acid, in Paper No. 5, filed June 9, 2003, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. As discussed immediately above, election was made **without** traverse in Paper No. 5, filed June 9, 2003.

Claims 20-26 are examined on the merits to the extent they read on the elected species.

Art Unit: 1651

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Cockrell et al (U.S. Pat. 4,877,459).

Cockrell discloses a cleaning composition comprising sulfamic acid in combination with citric acid (which has a dissociable proton with a pKa of 3.06, and itself can be used as a buffer) and a buffer component which may be sodium acid pyrophosphate (which includes a moiety with a pKa of 1.96) or monosodium phosphate (which includes a moiety with a pKa of 2.12), wherein the buffer is used to maintain a pH of 1 to 5. See column 5, line 31 through column 6, line 8. Because Cockrell discloses a composition containing the claimed ingredients at the claimed pH, a holding of anticipation is required.

It is noted that Cockrell's composition is intended for use as a cleaner, rather than the claim-specified diluent for

Art Unit: 1651

bacterial strain. However a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, based on the presence of the claimed ingredients in a solution having the claimed pH, the prior art composition clearly can be applied to the claimed intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a),

Art Unit: 1651

the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrell et al (U.S. Pat. 4,877,459) in view of Carrie et al (U.S. Pat. 5,912,219).

As discussed above Cockrell discloses a cleaning composition comprising sulfamic acid in combination with citric acid (which has a dissociable proton with a pKa of 3.06, and itself can be used as a buffer) and a buffer component which may be sodium acid pyrophosphate (which includes a pKa of 1.96) or monosodium phosphate (which includes a pKa of 2.12), wherein the buffer is used to maintain a pH of 1 to 5. Cockrell discloses that his acidic cleaning compositions require a surfactant component. See column 6, lines 15 and 16.

However, Cockrell differs from claims 22, 23 and 26 in that Cockrell does not disclosing the use of the claimed cationic surfactants in the disclosed composition. However, Carrie clearly discloses that quaternary ammonium compounds having formulae encompassing the claimed compounds are suitable, even "preferred," for use in acidic cleaning compounds of the type

Art Unit: 1651

disclosed in Cockrell. Thus, the artisan of ordinary skill, recognizing from Carrie the suitability of quaternary ammonium compounds in acidic cleaning compositions, clearly would have been motivated to have employed the quaternary ammonium compounds of Carrie as the surfactant component in Cockrell's compositions. A holding of obviousness is therefore required.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 703-308-3665. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Francisco C Prats
Primary Examiner
Art Unit 1651